Amendments to the Claims

Claims 23 and 25 have been cancelled without prejudice.

Claims 14, 16, 21 and 24 have been amended as indicated above.

In particular, claim 14 has been amended to correct an antecedent basis issue regarding the phrase "the print job", and claims 14 and 16 have been respectively amended to expand on (i.e., define) the abbreviation "PML", so to address rejection of those claims under 35 U.S.C. § 112, second paragraph. Support for the amendments to claims 14 and 16 with respect to the abbreviation "PML" can be found at least on page 5, lines 4-7 of the Specification as originally filed.

Claim 21 has been amended to include limitations directed to a message formatted as a print job and including the PML object UI_SELECT_OPTION. Support for the amendment to claim 21 can be found at least on page 2, line 10 to page 5, line 29 of the Specification as originally filed. Claim 24 has been amended to depend from claim 21 (as amended). No new matter has been introduced by the amendments to the claims.

Rejection of Claims under 35 U.S.C. § 112

Claims 14-20 and 25 stand rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Specifically, the Examiner has asserted that:

1) The term "the print job" as used in claim 14 is lacking proper antecedent basis; and

2) The abbreviation "PML" as used in claims 14, 16 and 25 is uncertain and should be expanded upon.

In regard to the § 112 rejection of claim 25, that claim has been cancelled as indicated above. Therefore, the § 112 rejection of claim 25 is now moot. In regard to claims 14 and 16, those claims have been respectively amended as indicated above to address the Examiner's grounds for § 112 rejection. As a result, the Applicants respectfully request that the § 112, second paragraph, rejection of claims 14-20, as respectively amended, be withdrawn.

Rejection of Claims under 35 U.S.C. § 103

Claims 21-24, 27, 29 and 31-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,898,823 ("Sorkin"), in view of U.S. Patent No. 6,728,012 ("Bacher"). Claim 28 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Sorkin and Bacher, in view of "Official Notice". Claims 14, 16 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sorkin and Laser Jet Series 4050 Printer Model Specific MIB, in view of "Official Notice". Claims 26 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sorkin and Bacher, in view of U.S. Patent No. 6,219,151 ("Manglapus"). Claims 15, 19 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sorkin and Laser Jet Series 4050 Printer Model Specific MIB, in view of "Official Notice as applied to claims 14 and 16, and in further view of Bacher. Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Sorkin and Laser Jet Series 4050 Printer Model Specific MIB, in view of "Official Notice" as applied to claims 14 and 16 above, and in further view of Manglapus. Claim 25 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Sorkin, Bacher and Laser Jet Series 4050 Printer Model Specific MIB, in view of "Official Notice".

Claims 23 and 25 have been cancelled as indicated above. Thus, the respective § 103 rejections of claims 23 and 25 are now moot.

Claim 15 depends from claim 14, as amended. Claims 17-20 depend, directly or indirectly, from claim 16, as amended. Claims 22, 24 and 26-32, as respectively amended, depend from claim 21, as amended. It is axiomatic that any claim depending (directly or indirectly) from an allowable base claim is also allowable. For this reason, the Applicants focus the following arguments in favor of allowability on independent claims 14, 16 and 21, as respectively amended. The Applicants do not believe it necessary to present arguments in favor of each and every dependent claim in order to demonstrate their respective allowabilities.

As a starting point, MPEP 706.02(j) states:

"[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, <u>there must be some suggestion or motivation, either in the cited references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings</u>. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations**. <u>The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.</u>" (Emphasis added.)

Claim 14

The Applicants assert that claim 14, as amended, and claim 15 that depends therefrom, are allowable. In regard to claim 14, as amended, the claim recites the following features and limitations:

A method for a client to discover a peripheral address, by way of a peripheral server, the method comprising:

1   sending a first message to the peripheral server, wherein the

2   first message contains an address of the client, and wherein the first

3   message is formatted <u>as a print job that contains a Peripheral</u>

4   <u>Management Language (PML) object, and wherein the PML object is</u>

5   <u>UI SELECT OPTION</u>, and wherein the print job includes no content

6   resulting in a printed output; and

7   receiving at the client a second message containing the

8   peripheral address.

9   (Emphasis added).

10

11   Sorkin fails to teach or suggest sending a first message to the peripheral

12   server, wherein the first message contains an address of the client, and wherein the

13   first message is formatted <u>as a print job that contains a Peripheral Management</u>

14   <u>Language (PML) object, and wherein the PML object is UI SELECT OPTION</u>, as

15   recited in combination with the other feature and limitations of claim 14, as

16   amended. In fact, the Examiner has admitted that Sorkin is specifically lacking the

17   PML object UI_SELECT_OPTION, or any suggestion or teaching directed thereto

18   (page 8 of Office Action).

19   Sorkin is directed to establishing direct communication between a client

20   computer 14 and a networked printer 24 by way of *SNMP traps* (Col. 2, lines 3-50 of

21   Sorkin). Sorkin fails to teach or suggest, in any context, the use of *any* PML object,

22   and Sorkin completely fails to teach or suggest use of the specific PML object

23   UI_SELECT_OPTION.

24   The Laser Jet Series 4050 Printer Model Specific MIB (hereinafter, the 4050

25   MIB) fails to cure the deficiency of Sorkin. Specifically, the 4050 MIB fails to teach

or suggest the particular PML object UI_SELECT_OPTION, as recited in

combination with the other features and limitations of claim 14, as amended. The

1 Examiner has acknowledged this deficiency on the part of the 4050 MIB (page 9 of

2 Office Action). However, the Examiner states at Para. 27 of the Office action:

3   "Although, The Laser Jet Series 4050 Printer Model Specific

4   MIB taught wherein the PML object is HELD_JOB_DELETE, however,

5   Sorkin and The Laser Jet Series 4050 Printer Model Specific MIB did

6   not specifically teach wherein the PML object is UI_SELECT_OPTION.

7   "Official Notice" is taken for the concept of using different type of PML

8   object is known and accepted in the art. It would have been obvious to

9   one having ordinary skill in the art at the time of the invention was

10   made to include different types of PML objects because by doing so it

11   would increase the field of use in their systems."

12

13   Respectfully, the Applicants contest this assertion that general knowledge in

14 the art of a "HELD_JOB_DELETE" PML renders use of the "UI_SELECT_OPTION"

15 PML of claim 14 obvious. Firstly, the Examiner has failed to demonstrate that, at the

16 time of the present invention, one of ordinary skill in the art would have been aware

17 that the PML object "UI_SELECT_OPTION" even *existed*, let alone that such an

18 artisan would find it obvious to apply that particular PML object in any way even

19 remotely similar to that as recited by instant claim 14, as amended. Second of all,

20 the mere existence of one PML does not render the existence of a second PML

21 obvious, and moreover, the particular use of a first PML does not render the use of a

22 second PML obvious for an entirely different purpose! There cannot be anything

23 obvious about that which is unknown.

24   In accordance with MPEP 2144.03(C), the Applicants respectfully request that

25 the Examiner provide evidence in support of "Official Notice" as taken with respect to

    demonstrating that one of ordinary skill in the art, at the time of the present

invention, was aware of the PML object UI_SELECT_OPTION, and how to apply that PML object as recited by claim 14, as amended.

In summary, the Examiner has failed to show that any of the cited references provide, teach or suggest the PML object UI_SELECT_OPTION, let alone that one having ordinary skill in the art at the time the invention was made would find it obvious to apply that PML object in any way even remotely similar to that as recited by instant claim 14, as amended. In view of the foregoing deficiencies, and in further view of the requirements as recited by MPEP 706.02(j), the Applicants assert that the § 103 rejection of claim 14, as amended, is unsupportable and should be withdrawn.

For at least these reasons, the Applicants assert that claim 14, as amended, is allowable. As claim 15 depends from claim 14, as amended, it is axiomatic that claim 15 is also allowable.

Claim 16

The Applicants assert that claim 16, as amended, and claims 17-20 that depend (directly or indirectly) therefrom, are allowable. In regard to claim 16, as amended, the claim recites the following features and limitations:

An apparatus comprising:

a client computer;

a peripheral server, connected to the client computer, wherein the peripheral server receives a first message from the client computer, the first message containing an address of the client computer; and

a peripheral, connected to the peripheral server, wherein the peripheral receives the first message from the peripheral server and notifies the client computer of the peripheral's address, wherein:

the first message is formatted as a print job, the print job including no content resulting in a printed output, and wherein the print job contains a Peripheral Management Language (PML) object, and wherein the PML object is UI_SELECT_OPTION;

the peripheral includes at least one non-printer function; and

the client computer is configured to access the at least one non-printer function of the peripheral using the peripheral's address and without using the peripheral server.

(Emphasis added.)

Sorkin fails to teach or suggest a print job [that] contains a Peripheral Management Language (PML) object, and wherein the PML object is UI_SELECT_OPTION, as recited in combination with the other features and limitations of claim 16, as amended. The 4050 MIB fails to cure the deficiency of Sorkin. In particular, the 4050 MIB fails to teach or suggest a print job [that] contains a Peripheral Management Language (PML) object, and wherein the PML object is UI_SELECT_OPTION, as recited in combination with the other features and limitations of claim 16, as amended. The Applicants respectfully reiterate their request under MPEP 2144.03(C) as stated above for provision of evidence in support of "Official Notice" as taken by the Examiner in regard to the PML object UI_SELECT_OPTION. In view of the deficiencies described above, the Applicants assert that the § 103 rejection of claim 16, as amended, is unsupportable in view of

1 MPEP 706.02(j) and should be withdrawn.

2   For at least these reasons, the Applicants assert that claim 16, as amended,

3 is allowable. As claims 17-20 depend (directly or indirectly) from claim 16, as

4 amended, it is axiomatic that claims 17-20 are also allowable.

5

6 Claim 21

7   The Applicants assert that claim 21, as amended, and claims 22, 24 and

8 26-32 (as respectively amended) that depend therefrom, are allowable. In regard to

9 claim 21, as amended, the claim recites the following features and limitations:

10

11   A method for communication between networked devices, the

12   method comprising:

13   sending a first message from a client to a peripheral server by

14   way of a network, the first message including a network address of the

15   client, and wherein the first message is formatted as a print job

16   containing a Peripheral Management Language (PML) object, and

17   wherein the PML object UI_SELECT_OPTION;

18   sending the first message from the peripheral server to a

19   multifunction peripheral by way of the network;

20   sending a second message from the multifunction peripheral to

21   the client by way of the network, the second message including a

22   network address of the multifunction peripheral; and

23   accessing a non-printer function of the multifunction peripheral

24   by way of the network using the client and the network address of the

25   multifunction peripheral and without using the peripheral server.

        (Emphasis added.)

Sorkin fails to teach or suggest a <u>first message is formatted as a print job</u> <u>containing a Peripheral Management Language (PML) object, and wherein the PML</u> <u>object UI_SELECT_OPTION</u>, as recited in combination with the other features and limitations of claim 21, as amended. Again, Sorkin is directed to establishing communication by way of SNMP traps. This is not the same as the invention as recited by claim 21, as amended.

Bacher fails to cure the deficiencies of Sorkin. Specifically, Bacher fails to teach or suggest a <u>first message is formatted as a print job containing a Peripheral</u> <u>Management Language (PML) object, and wherein the PML object</u> <u>UI_SELECT_OPTION</u>, as recited in combination with the other features and limitations of claim 21, as amended.

Rather, Bacher is directed to a multifunction terminal wherein an arrangement of feeding stations 12, 14, intermediate storing trays 62, 63, and feeding members 77 are cooperatively disposed with respect to a printer 51, a data reader 55, etc., along a feeding path 18 (Abstract; Fig. 1 of Bacher). In short, Bacher is directed to a particular arrangement of sheet media handling parts and sub-systems within a multifunctional device. Bacher provides no teaching or suggestion whatsoever in regard to sending the first message from the peripheral server to a multifunction peripheral by way of the network, sending a second message from the multifunction peripheral to the client by way of the network, the second message including a network address of the multifunction peripheral, and then accessing a non-printer function of the multifunction peripheral by way of the network using the client and the network address of the multifunction peripheral and without using the peripheral server, as recited in combination with the other features and limitations of claim 21, as amended. Bacher does not teach or suggest use of any PML object, in any way.

There is no way to combine elements selected from Sorkin, and then to somehow combine those elements with other elements selected from Bacher, in

order to arrive at the invention as recited by claim 21, as amended, as no possible combination of Sorkin with Bacher teaches or suggests all of the necessary limitations. This deficiency renders the § 103 rejection of claim 21, as amended, unsupportable in view of the requirements of MPEP 706.02(j). The fact is, none of the references cited thus far in the case record provide, teach or suggest the PML object UI_SELECT_OPTION of claim 21.

For at least these reasons, the Applicants assert that claim 21, as amended, is allowable. As claims 22, 24 and 26-32 (as respectively amended) depend from claim 21, as amended, it is axiomatic that claims 22, 24 and 26-32, as respectively amended, are also allowable.

Rejection of Claims under Non-Statutory Double Patenting

Claim 14 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 7 of U.S. Patent No. 6,559,965 ("Simpson at al.") (pages 2-3 of Office Action).

In light of the fact that the claim 14 has been amended, the Applicants respectfully request reconsideration of the obviousness-type double patenting of this claim in light of the amendments.

Status of Instant Application

The Examiner's statement that the instant application is currently pending as a result of a request for a Continued Prosecution Application (CPA), as filed on 12/27/04 in accordance with 37 CFR 1.53(d), is not correct (page 2 of Office Action).

In fact, the instant application is currently pending as a result of a Request for Continued Examination in accordance with 37 CFR 1.114, as deposited with the United States Postal Service as First Class mail on December 20, 2004. The Examiner is respectfully referred to that submission to the Office.

Summary

The Applicants believe that this response constitutes a full and complete response to the Office Action dated February 16, 2005. Therefore, the Applicants respectfully request examination on the merits of claims 14-22, 24, and 26-32, as respectively amended, in favor of timely allowance.

The Examiner is respectfully requested to contact the below-signed representative if the Examiner believes this will facilitate prosecution toward allowance of the claims.

Respectfully submitted,

Larry A. COPP
Matt HOWELL

Date: __May 11, 2005__   By _____
John S. Reid
Attorney and Agent for Applicant(s)
Reg. No. 36,369
Phone: (509) 534-5789